

REMARKS/ARGUMENTS

Claims 1-10, all of which have been amended by this Amendment, are all of the claims pending in the application after entry of this Amendment.

In the Office Action, claims 1-10 were rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,064,887 to Kallioniemi et al. ("Kallioniemi").

Applicants, by their attorney, respectfully disagree with the Examiner's conclusion that claims 1-10 of the present application are anticipated by Kallioniemi.

In order to serve as a basis for pointing out to the Examiner the reasons why Applicants and their Attorney believe that claims 1-10 of the present application are not anticipated by Kallioniemi, it is thought that a brief discussion of the system and method of both the reference and the present application is first warranted.

Kallioniemi relates to a telecommunications network (10), which includes a set of service provider/operator domains (20), including mobile telecommunications domains (20 A-C). A call originating domain (20F) accesses a mobile subscriber number portable database to obtain the address of the gateway node of the telecommunications domain which currently serves a called mobile subscriber having a mobile station (70) and optionally the address of the home location register (HLR) of the called mobile subscriber. The address of the gateway node, and optionally the address of the home location register (HLR) obtained from the database are included along with the directory number (MSISDN) or IMSI of the called mobile subscriber in a routing message for completing the call. The portability of the mobile subscriber number database. Access to the database and usage of the address of the gateway node of the new domain in the routing message, permit the mobile subscriber to retain the same MSISDN when changing service providers.

In contrast, the system and method of the present invention, as disclosed in the specification and as recited according to amended claims 1-10 of the present application, relate to control of a subscriber identity module (SIM) in a data communication system, such as a mobile communication system., wherein the system includes first and second subscriber registers (HLR1 and HLR2) for maintaining subscriber records that define a subscriber identity module registry; a short message transmission system (SMSC) for transmission of messages within the communication system; and a mobile station (MS), connected to the subscriber identity module (SIM) for use by a subscriber in effecting mobile communication through the system. The SIM

stores therein data which includes a first subscriber identity code (IMSI1) and an encryption code key (K_i) corresponding to a first subscription for the mobile station subscriber and associated with the subscriber identity module. A record of data corresponding to the first subscription is created in the first subscriber register (HLR1) when the first subscription is opened, with the record including a first subscription specific call number (MSISDN_x), the encryption code key (K_i), and a subscriber identity code (IMSI1) for the mobile station subscriber. A second subscription for the mobile station subscriber, associated with the subscriber identity module (SIM) is then opened, and a record corresponding to the opened second subscription and including a second subscription-specific call number (MSISDN), a second subscriber identity code (IMSI1), and the encryption key (K_i) is created in the second subscriber register (HLR2). A message (SMS) is then sent through the communication system, directed to the first subscription, instructing that the data stored in the subscriber identity module be changed from data corresponding to the first subscription to data corresponding to the second subscription. In response to receipt of the message (SMS) directed to the first subscription, the data stored in the subscriber identity module is changed to the data corresponding to the second subscription.

From the foregoing, it is evident that Kallioniemi is not relevant at all to the system and method of the present application.

It is respectfully submitted that the Examiner has sought to base the anticipation rejection of the claims of the present application in view of Kallioniemi on a mere finding of some similar or similarly termed elements in the systems of the present application and that of the reference, although the overall systems and their methods of operation are completely different as summarized above and as fully discerned from a detailed reading of the reference and the present application.

It appears that the Examiner may have misapprehended the object of the system and method of the present application as being to transfer data from one HLR to another, inasmuch as in the detailed, specific arguments presented by the Examiner in the Office Action, the alleged similarities between the system and method of the present application and those of Kallioniemi appear to be presented in such a context.

The object of the system and method of the present application, however, is to allow controlling a subscriber identity module connected to a mobile station (see application at page 15, line 6), i.e. to allow easily updating or changing data in the subscriber identity module, so

that a communication system operator may improve its customer service (see application at page 4, lines 7-12).

To achieve this object, the present application teaches changing data stored in a subscriber identity module, and currently associated with a first subscription, into data associated with a second subscription in response to a message received by a mobile station connected to said subscriber identity module, which message instructs the performance of said change of data (application at claim 1, last two steps; page 5, line 19 - page 6, line 4).

Kallioniemi fails to teach or suggest anything even remotely similar to the features of the present application discussed above. Rather, Kallioniemi merely discloses the feature of portability of mobile subscriber numbers. As is known to persons of ordinary skill in the art, the portability of mobile subscriber numbers refers to the feature of a subscriber's MSISDN number remaining the same even when the subscriber changes from one service provider to another (Kallioniemi; abstract). It is also commonly known in the art that the portability of mobile subscriber numbers includes not changing the subscriber's MSISDN number or any other subscription data stored in a subscriber identity module. Rather, any changes to the subscription data are performed in network elements such as a Home Location Register or a number portability database, as is disclosed by Kallioniemi (abstract), and as recognized by the Examiner (Office Action, page 3, last few lines of first paragraph).

In the amendments to claims 1-10 presented hereinabove, Applicants by their Attorney, have made certain amendments which are intended to clarify the claims and to more precisely recite and distinctly claim the subject matter which Applicants regard as the invention. No new matter has been introduced by any of the amendments. Support for all of the amendments is found in the specification as originally filed. The claims, particularly independent claims 1 and 8 have been extensively reformatted to facilitate the reading and interpretation of those claims.

Because the amendments to the claims and the arguments distinguishing the system and method of the present invention over Kallioniemi, as presented by this Amendment, are believed to place the claims in-condition-for-allowance and to generally show the distinctions between the subject matter of the present application and that of the reference, it is believed that a claim-by-claim refutation of the bases for the Examiner's rejection, as set forth in the Office Action, is not necessary and would be superfluous. Applicants and their attorney wish to make it clear, however, that the Examiner should not construe this to be an omission of the response to the Office Action

that might cause the Examiner to deem this Amendment to be not completely responsive to the Office Action. As stated above, it is respectfully submitted that the claim-by-claim detailed rejection merely serves to point out that the subject matter of the present application and that of the reference coincidentally share certain similar individual elements and/or terminology for such elements, but are completely different in purpose and function.

The other references cited by the Examiner and made of record, but not applied to the claims, have been noted by Applicants and their Attorney, however nothing in any of them is believed to be more relevant than Kallioniemi.

It is requested that the Examiner enter the Amendment into the file of the subject case and that the application be reconsidered and further examined in light of the amendments to the claims and the accompanying remarks presented by the Amendment. It is believed that amended claims 1-10 are in allowable condition and that the amendments and accompanying arguments successfully overcome the bases for the Examiner's previous rejection of the claims in view of Kallioniemi. It is believed that after reconsideration and further examination, the Examiner will find the application, including amended claims 1-10 to be in-condition-for-allowance, the early notification of which is earnestly solicited.

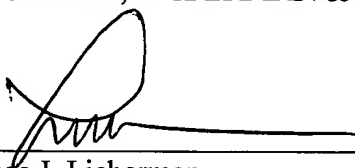
On the Office Action Summary sheet, box b of line 13 was checked indicating that only some certified copies of priority documents were received. No further mention was made, however, in the Office Action, as to which, if any, such documents are yet outstanding. Applicants' attorney requests clarification as to what documents are still needed. Enclosed is a copy of the return receipt postcard stamped by the United States Patent Office stating that they have received copies of the two priority documents.

This Amendment is being filed within the original three month shortened statutory period for response to the Office Action. Accordingly, no extension of time to respond or fee therefore is required. No changes in the number or type of the pending claims in the application have been made by this Amendment, therefore no additional claims fees are due at this time. It is believed that no other fees or charges are required at this time in connection with the present application; however, if any such other fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By



Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: December 10, 2003